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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/309,131	05/10/1999	TERRY L. GEER	0258100-1002	7132
7590	06/23/2004			
PORTER WRIGHT MORRIS & ARTHUR 41 SOUTH HIGH STREET 28TH FLOOR COLUMBUS, OH 432156194			EXAMINER SNAPP, SANDRA S	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/309,131

Applicant(s)

GEER, TERRY L.

Examiner

Sandra Snapp

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1,4,8-11,18,19 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-3, 5-7, 12-17, 20-23, and 25-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

Current Status of Application

This Office Action is in response to the Amendment/RCE filed on 3-23-04. Claims 2-3, 5-7, 12-17, 20-23 and 25-32 are currently pending in the application. Claims 1, 4, 8-11, 18-19 and 24 have been cancelled in prior Amendments.

Claim Rejections - 35 USC § 112

The rejection of claims 2-3, 5-7 and 12-30 based on 35 U.S.C. 112, second paragraph have been overcome.

Claim Rejections - 35 USC § 103

Claims 2, 3, 5-7, 12-17, 20-23 and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens et al. (US 5,237,159) in view of Behera (US 5,187,750).

The Stephens patent discloses a system for effecting the deposit and submission of paper and financial instruments comprising:

An item capture facility for receiving the instruments (partner banks, col. 4, lines 57-68) (claims 31 and 32);

A means at the capture facility for deriving funds transfer information and converting the information into a data record (CPCS, col. 4, lines 57-68 and col. 5, lines 1-10) (claims 31 and 32);

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A means for associating information in the data record with a record associated with the payor maintained in the payee's record of accounts (CIF system, col. 5, lines 65-68 and col. 6, lines 1-68) (claims 31 and 32);

A means for associating information in the data record for each instrument with a record associated with the payor maintained in the payee's records of accounts (CIF system, col. 5, lines 65-68 and col. 6, lines 1-68) (claims 31 and 32);

An archive (centralized storage, col. 6, lines 3-68) (claims 6, 7, 27, 31 and 32);

A communication link (communication techniques, col. 5, lines 22-29) (claims 31 and 32);

A processing means (CPCS, col. 5, lines 1-10) (claims 31 and 32);

A sorter for identifying record according to categories and for assembling bundles of records corresponding to the categories (system that bundles checks, col. 5, lines 11-21) (claims 31 and 32);

A means for applying an indorsement indicia on behalf of the payee and the depository bank of the payee (headers, col. 8, lines 1-68) (claim 32); and

A controller that coordinates the transmission of cash letter information (CPCS, col. 5, lines 11-21) (claims 31 and 32);

The data record includes information corresponding to the MICR line (col. 4, lines 57-67) (claims 2 and 5);

The capture facility includes means for receiving one or more checks (col. 4, lines 57-67) (claims 3 and 30);

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More than one cash letter is delivered into the payment system (col. 5, lines 11-21) (claims 12, 20 and 28);

Cash letters include electronic cash letters and paper cash letters (col. 5, lines 11-29) (claims 13, 21 and 29); and

The payment system to which cash letters are delivered is one of the Federal Reserve and a private clearing house (col. 3, line 62 through col. 4, line 5) (claims 22 and 23).

The Stephens patent lacks:

The visually perceptible record of the financial instrument is transmitted to the custodian of the payor's account, and an image derived from the visually perceptible record is displayed in a periodic statement delivered on behalf of the custodian to the payor (claims 31 and 32);

the means for creating a visually perceptible record comprises an imager that creates an electronic image (claims 3 and 30);

an image of the visually perceptible record associated with the payment is returned to the payor in paper format (claims 14 and 15) and electronic format (claims 16 and 17); and

the financial instrument is disposed of after a visually perceptible record of the financial instrument is created (claims 25 and 26).

The Behera patent teaches:

The means for creating a visually perceptible record comprises an imager that creates an electronic image (8i, col. 4, lines 10-23) (claims 3 and 30);

An image of the visually perceptible record associated with the payment is returned to the payor in paper format (col. 8, lines 27-35 and col. 9, lines 38-41) (claims 14 and 15) and electronic format (col. 4, lines 43-62, since the system already provides for the images to be transferred from one location to another, and it allows for the records to be returned to the payor in printed paper form it is obvious that the records could more readily and easily be transferred via electronic form to the payor and save the time, cost and energy associated with printing out the record) (claims 16 and 17); and

The financial instrument is disposed of after a visually perceptible record of the financial instrument is created (Examiner takes official notice that it is common knowledge that physical documents are disposed of once images have been made thereof so as to save storage space and provide for more easily accessible documents) (claims 25 and 26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Stephens patent with the teachings of the Behera patent so as to provide a more efficient, cost effective and less redundant system. Also so as to reduce the amount of energy and effort that was spent physically moving papers from one location to another.

Response to Arguments

Applicant's arguments filed 3-15-04 have been fully considered but they are not persuasive. The Examiner appreciates the Applicant's adding claims 31 and 32 that strictly incorporate the limitations of dependent claims 10-11, which were previously identified as containing allowable subject matter. However, in the Office Action of 9-24-03, the Examiner

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made a new 103(a) rejection, based on the Stephens patent, in view of the Behera patent. The Behera patent teaches the limitations previously identified in claims 10 and 11 as being allowable. As such, the present application remains rejected as being obvious in view of the Stephens patent as modified by the Behera patent.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SS
June 20, 2003


SANDRA S. SNAPP
PATENT EXAMINER
GROUP 3600